

REMARKS*1. Status of claims*

After entry of the above amendment, claims 1-24 are pending.

2. Support for amendment

The above amendment of claims 11 and 24 corrects minor errors that resulted in a lack of antecedent basis in the claims as discussed at paragraph 3 below. Claim 1 has been amended to correct a typographical error. No new matter has been added by this amendment.

3. Claim rejections under 35 U.S.C. §112

The Examiner rejected claims 11, 12, and 24 under 35 U.S.C. §112, second paragraph, for being indefinite. Specifically, claim 11 was considered indefinite for reciting the term "mineralized supernatant solution" whereas its parent claim recited a "mineral-containing acid supernatant" and claim 24 was considered indefinite for lacking antecedent basis for the term "the protein supernatant solution."

Claim 11 has been amended to recite "mineral-containing acid supernatant." Claim 24 has been amended to recite "mineral-containing acid supernatant," for which antecedent basis exists. Therefore, Applicant submits the bases for this rejection of claims 11, 12, and 24 have been removed.

4. Claim rejections under 35 U.S.C. §§102 and 103

The Examiner rejected claims 1-5, 9-19, and 24 under 35 U.S.C. §102(b) as being anticipated by Urist, US 4,294,753 ("Urist") and claims 1-24 under 35 U.S.C. §103(a) as being unpatentable over Urist, as described above, in view of Poser *et al.*, US 5,371,191 ("Poser") and Urist, US 4,619,989 ("Urist '989"). Applicant respectfully traverses these rejections.

The present claims recite processes or methods of extracting osteogenic proteins from mammalian bone tissue. All the claimed processes or methods include extracting osteogenic proteins from a **mineral-containing** supernatant or a supernatant derived therefrom.

Urist also teaches processes or methods of extracting osteogenic proteins from mammalian bone tissue. However, in contrast to the present claims., Urist teaches extracting osteogenic proteins from a **demineralized** supernatant (col. 3, lines 1-12, col. 5, lines 12-18 and 25-26, and the Drawing). Indeed, the exemplary process of Urist teaches away from the present claims by repeatedly replacing [and inferentially discarding] his mineral-containing demineralization solution (see col. 5, lines 19-24). Moreover, Poser *et al.* teach: a) extracting osteogenic proteins only from demineralized bone (see col. 3, lines 34-37, col. 4, line 66 – col. 5 line 22, col. 10, lines 5-9 and claims 22 and 30); and b) nothing about extracting osteogenic proteins from a supernatant, mineralized or not (see col. 9, line 64 – col. 10, line 3).

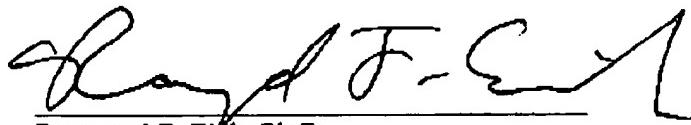
In view of the foregoing, Urist and/or Poser *et al.*, either alone or in combination, do not anticipate or render obvious the present claims. As such, Applicant respectfully requests the rejections of claims 1-5, 9-19, and 24 and 1-24 be withdrawn.

5. Final remarks

Applicant submits all pending claims 1-24 are in condition for allowance. The Examiner is invited to contact the undersigned patent agent at (713) 934-4065 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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